

Application No.: 09/643260

Docket No.: YAI-001  
(formerly PPI-117)

### **REMARKS**

Claims 1-22 and 24-27 were pending in the above-identified patent application. Claims 24-27 have been cancelled, without prejudice, claim 19 has been amended and new claims 28-46 have been added. Therefore, after the amendments presented herein have been entered, claims 19-21 and 28-46 will remain pending.

Support for the amendments to the claims can be found throughout the specification and the claims as originally filed. Specifically, support for the amendments to claim 19 can be found at, for example, page 25, line 27.

No new matter has been added. Any amendments to and/or cancellation of the claims should in no way be construed as an acquiescence to any of the Examiner's rejections and was done solely to more particularly point out and distinctly claim the subject matter of the invention and to expedite the prosecution of the application. Applicants reserve the right to pursue claims as originally filed in this or a separate application(s).

### ***Request for Reconsideration of the Finality of the Action***

Applicants respectfully request reconsideration of the finality of the present Office Action. The final rejection was improperly issued because it raised new grounds of rejection, *i.e.*, the rejection of claims 19-21 under 35 U.S.C. §102(b) over Rothe *et al.* and the rejection of claim 19 under 35 U.S.C. §102(a) over Adams *et al.* These rejections were not necessitated by Applicants' amendments to the claims or information submitted in an information disclosure statement filed during the period set forth in 37 C.F.R. §1.97(c). (See M.P.E.P. §706.07(a)). The claims that are now being rejected were pending in the same form when the Examiner issued the first Office Action. Applicants have been deprived of an opportunity to respond to the new grounds of rejection or to develop clear issues before the advisability of an appeal. Accordingly, Applicants respectfully request that the finality of the present Office Action be reconsidered and withdrawn.

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***Acknowledgement of the Examiner's Withdrawal of Certain Rejections and the  
Indication of Certain Claims as Allowable***

Applicants gratefully acknowledge the Examiner's withdrawal of the following: (a) The previous rejection of claims 19-22 under 35 U.S.C §112, first paragraph and (b) The previous rejection of claims 19-22 under 35 U.S.C. §102.

Applicants further gratefully acknowledge the Examiner's indication of claim 22 as allowable.

***Rejection of Claims 19-21 Under 35 U.S.C § 102 (b) Over Rothe et al.***

The Examiner has rejected claims 19-21 under 35 U.S.C. § 102(b) as anticipated by Rothe *et al.* (WO 99/01541, January 14, 1999). The Examiner relies on Rothe *et al.* for disclosing "an IKK-alpha protein, which has 100% sequence identity to SEQ ID NO: 2 (see sequence alignment result Cao et al., A\_Geneseq\_101002 database, Accession NO: AAW96182, April 27, 1999)." In particular, the Examiner is of the opinion that

[t]his reads on claims 19, 20, and 21, which has an isolated polypeptide comprising an amino acid sequence selected from the group consisting of SEQ ID NO: 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, and 19 (claim 19). See the sequence alignment attached to the Cao et al. reference. As to claims 20 and 21, the Rothe et al references discloses a composition comprising the IKK-alpha polypeptide (page 3, line 1) that would have been the composition that contains the peptide to claim 19.

Applicants respectfully traverse the aforementioned rejection, as it does not apply to the claims as amended. For a prior art reference, in terms of 35. U.S.C. § 102, to anticipate a claimed invention, the prior art must teach *each and every element* of the claimed invention. Lewmar Marine v. Bariant, 827 F.2d. 744, 3 USPQ2d 1766 (Fed. Cir. 1987).

To begin with, new claim 28 does not contain SEQ ID NO:2. Thus, this claim is novel over Rothe *et al.*

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With respect to claim 19, Applicants respectfully submit that Rothe *et al.* fail to teach each and every element of the claimed invention for the following reasons. Claim 19 and claims depending therefrom, as amended, are directed to an isolated peptide comprising an amino acid sequence selected from the group consisting of SEQ ID NO: 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16 and 17, 18 and 19, *wherein said peptide is less than one-hundred amino acids in length*. Rothe *et al.* disclose IKK- $\alpha$  polypeptides which are 756 amino acids (SEQ ID NO:2) and 745 amino acids (SEQ ID NO:4) in length. Thus, Rothe *et al.* do not teach or suggest each and every element of the pending claims. Accordingly, Applicants respectfully request that this 35 U.S.C. §102(b) rejection be reconsidered and withdrawn as applied to the pending claims.

***Rejection of Claim 19 Under 35 U.S.C § 102 (a) Over Adams et al.***

The Examiner has rejected claim 19 under 35 U.S.C. § 102(a) as anticipated by Adams *et al.* (Science, vol. 287, pp 2185-2195, March 24, 2000). The Examiner relies on Adams *et al.* for disclosing

a CG606 protein from *Drosophila melanogaster*, which has 100% sequence identity to SEQ ID NO: 9 (see sequence alignment results, Adams *et al.*, SPTREMBL\_21, which has an isolated polypeptide comprising an amino acid sequence selected from the group consisting of SEQ ID NO: 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16 and 17, 18 and 19.

Applicants respectfully traverse the aforementioned rejection, as it does not apply to the claims as amended. For a prior art reference, in terms of 35 U.S.C. § 102, to anticipate a claimed invention, the prior art must teach *each and every element* of the claimed invention. Lewmar Marine v. Bariant, 827 F.2d. 744, 3 USPQ2d 1766 (Fed. Cir. 1987).

To begin with, new claim 28 does not contain SEQ ID NO:9. Thus, this claim is novel over Adams *et al.*

With respect to claim 19, Applicants respectfully submit that Adams *et al.* fail to teach each and every element of the claimed invention for the following reasons. Claim 19, as

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amended, is directed to an isolated peptide comprising an amino acid sequence selected from the group consisting of SEQ ID NO: 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16 and 17, 18 and 19, *wherein said peptide is less than one-hundred amino acids in length*. Adams *et al.* disclose sequences with accession numbers AE002566-AE003403. The sequence relied on by the examiner is accession number AE003544 (See sequence alignment provided by the Examiner.). The protein disclosed in accession number AE003544 is 295 amino acid residues in length. Thus, Adams *et al.* do not teach or suggest each and every element of the pending claims. Accordingly, Applicants respectfully request that this 35 U.S.C. §102(a) rejection be reconsidered and withdrawn as applied to the pending claims.

#### SUMMARY

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 12-0080, under Order No. YAI-001 from which the undersigned is authorized to draw.

Dated: October 3, 2003

Respectfully submitted,

By 

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Registration No.: Limited Recognition Under 37 C.F.R. § 10.9(b)

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